

REMARKS/AGRUMENTS

In response to the above-identified Office Action, Applicants have amended their application and respectfully request reconsideration thereof.

Claims

Claim 1 includes a limitation corresponding substantially to that of cancelled claim 6. In addition, the word "automatically" has been included in the claim to emphasize that the determination of the topic and the selection of character strings from the database are performed automatically. Support for including the word "automatically" may be found at page 20, line 20 – page 21, line 8. Claim 9 has been similarly amended.

Claims 1-5, 7 and 9 have been amended to improve form.

Claim 8 has been cancelled.

Response to Claim Objections

Claims 3 and 4 have been objected to because of unclear language or the misuse of language.

Claim 3 has been amended to replace the word "test" with the word "text".

Claim 4 has been amended to delete the word "mousing".

Response to Claim Rejections – 35 USC § 102

Claims 1, 3, 4 and 9 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,092,074 (hereinafter Rodkin).

Applicants respectfully submits that claims 1, 3, 4 and 9 should not be rejected under 35 U.S.C. § 102(e) for the reason that Rodkin does not disclose each and every limitation of the claim 1, as amended, of their present application.

To anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Claim 1, as amended, includes the following limitation:

A method for automatically inserting hyperlinks into a webpage containing text....

...automatically determining a topic of the text, wherein the character strings are automatically selected from the database based upon the topic.

The Office Action, in rejecting claim 1, contends that Rodkin does not teach the above limitation; nevertheless, the Office Action indicates that Rodkin discloses the following:

The method may comprise the further steps of receiving designated character strings from the primary computers via the communication network in the periodic maintenance mode; wherein the designated character strings are designated by an administrator input at the primary computers; updating the annotation database with the designated character strings if the designated character strings are not present in the annotation database.

Rodkin, Col. 10, lines 25-32.

The above quote from Rodkin discloses an administrator that inputs or designates a character string at a primary computer. The primary computer subsequently communicates the character string over a communications network to an unnamed device that receives the character string and updates an annotation database if the character string is not present in the annotation database.

In addition the Office Action states...

It would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to use the invention of Rodkin et al. to determine a general topic, by administrator input and search engine results, so that the users are only provided with further information about the major theme(s) or general topic of the text.

Claim 1 requires automatically determining a topic of text in a web page, the character strings being automatically selected from the database based upon the topic of text in the web page. For example, consider a host that is inserting links into a web page. Continuing with the example, the host automatically determines that the web page is related to the topic "cars" and then automatically selects character strings from the database (page 21, lines 2-4) that are related to the topic "cars", the selected character strings compared with character strings in the web page and, responsive to a match, the host inserting links into the web page. In contrast to the limitation of claim 1, the above quote from Rodkin does not disclose automatically determining a topic of a

text in web page, but rather, an administrator that manually inputs character strings at a primary computer. Indeed, the inputted character strings may subsequently be communicated to an unnamed device that updates an annotation database that is utilized by the unnamed device to insert a URL into the text file; but nowhere in the above quote does Rodkin disclose a web page, much less automatically determining the topic of the text in a web page, much less, automatically selecting character strings from a database based on the topic of the text in the web page. Rodkin therefore cannot be said to anticipate the above quoted limitation because Rodkin discloses an administrator that manually inputs character strings at a primary computer and claim 1 requires automatically determining a topic of text in a web page, the character being automatically selected from a database based upon the topic of text in the web page.

In summary, Rodkin does not disclose each and every limitation of claim 1, as required to support a rejection of this claim under 35 U.S.C. § 102(e).

Independent claim 9 includes a limitation corresponding substantially to the above-discussed limitation of claim 1. Accordingly, Applicants request that the above remarks and amendments contained herein also be considered when examining these other independent claims for allow ability.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 3-4 under 35 U.S.C. 102(e) is also addressed by the above remarks, and the amendments contained herein.

Response to Claim Rejections – 35 USC § 103

Claims 2, 5, and 7-8 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over U.S. Patent No. 6,092,074 (hereinafter Rodkin).

Applicants respectfully submit that claims 2, 5, and 7-8 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application. Reasons for rejection of claims 2, 5, and 7-8 appear below.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claims 2, 5, and 7-8 depend on independent claim 1. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2, 5, and 7-8 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Rodkin does not teach or suggest each and every limitation of claims 2, 5-8 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

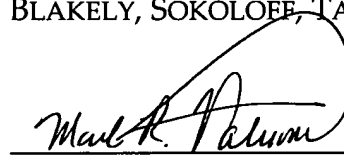
In summary, Applicants believe that all rejections presented in the Office Action have been fully addressed and withdrawn of these rejections is respectfully requested. Applicants furthermore believe that all claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact Mark Vatuone at (408) 947-8200.

Respectfully submitted,

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